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| 10/787,253 | 02/26/2004 | David D. Ladd | | 1316 |

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| EXAMINER | |
|---|---|
| BEKKER, KELLY JO | |
| ART UNIT | PAPER NUMBER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/787,253 | LADD ET AL. | |
| | Examiner | Art Unit | |
| | Kelly Bekker | 1794 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *04 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *34-39,41,43-51,53,55-66 and 69-84* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *34-39,41,43-51,53,55-66 and 69-84* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/16/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

**DETAILED ACTION**

Amendments made 11/4/08 have been entered.
Claims 34-39, 41, 43-51, 53, 55-66, and 69-84 are pending.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 4, 2008 has been entered.

***Specification***

The abstract of the disclosure is objected to because it is greater than one paragraph. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The previous 112 2nd paragraph rejections of claims 35-56 and 65-69 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been withdrawn in light of applicant's amendments made November 4, 2008.

The following 112 2nd paragraph rejections are pending:

Claims 57 and 81-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sucrose equivalency" in claim 57 is a relative term which renders the claim indefinite. The term "sucrose equivalency" is not defined by the claim, the

specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what sweeteners would be equivalent to sucrose and as to which sweeteners would not be considered equivalent to sucrose. Additionally, it is unclear as to if the sucrose equivalency is in relation to sweetness or some other property provided by sucrose.

The term "sucrose equivalent content" in claims 81-84 is a relative term which renders the claim indefinite. The term "sucrose equivalent content" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what sweeteners would be equivalent to sucrose and as to which sweeteners would not be considered equivalent to sucrose. Additionally, it is unclear as to if the sucrose equivalent content is in relation to sweetness or some other property provided by sucrose.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 81 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5126156) in view of Tomita et al. (US 5403611).

Jones teaches of a method for forming a pelletized dessert product comprising introducing a premix into a body of liquid cryogen (Column 2 lines 16-29). Jones teaches that the frozen dessert can be an ice cream product (Column 1 lines 10-15). Jones teaches that the final product is maintained in a freezer at about –29C if it is to be stored for periods greater than 30 hours, and that prior to serving, the product is kept at a temperature of about -26C for up to 30 hours (Abstract, Column 2 lines 57 through

Column 3 line 12). Thus one of ordinary skill in the art at the time the invention was made would expect the pellets as taught by Jones to maintain their individuality at a temperature of about -26C (i.e. including -25C) for at least less than 30 hours.

Jones teaches the premix can be dairy based (Column 4 lines 56-62), however, is silent to the specific composition utilized to form the ice cream dairy dessert.

Tomita teaches that ice creams are generally made from 3-20% milk fat, 3-12% non-fat milk solids, 8-20% sugar, i.e. sucrose, and if necessary, a small amount of a stabilizer, an emulsifier, a color, flavors, and the like (Column 1 lines 45-64). Since Tomita does not teach bulking agents as part of the composition, Tomita teaches that bulking agents are not included in the ice cream (Column 1 lines 45-64).

Regarding the specific composition and premix utilized to form the ice cream dairy dessert, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mix comprising 3-20% milk fat, 3-12% non-fat milk solids, 8-20% sucrose, no bulking agents, and if necessary, a small amount of a stabilizer, an emulsifier, a color, flavors, and the like for the ice cream dessert product as taught by Jones in view of Tomita. One would have been motivated to do so since Jones teaches of making a dairy based ice cream product but does not teach a composition for doing so, and since Tomita teaches of a general dairy based composition for ice cream products which provides for good flavor and excellent softness (Column 13 lines 12-25). One would have been further motivated for the ice cream ingredients to be combined in the form of a premix and for the ice cream to consist essentially of the premix so that the premix could be stored and when it was desirable to form the ice cream less processing steps were needed, i.e. such as measuring and combining all ingredients.

Claims 34-39, 41, 43-51, 53, 55-66, 69-80, 83, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5126156) in view of the combination of Tomita et al. (US 5403611), Cole et al. (US 4374154), and Igoe et al. (Dictionary of Food Ingredients, 3rd Edition 1996).

Jones teaches of a method for forming a pelletized dessert product comprising introducing a premix into a body of liquid cryogen (Column 2 lines 16-29). Jones teaches that the frozen dessert can be an ice cream product (Column 1 lines 10-15). Jones teaches that the final product is maintained in a freezer at about –29C if it is to be stored for periods greater than 30 hours, and that prior to serving, the product is kept at a temperature of about -26C (Abstract, Column 2 lines 57 through Column 3 line 12). Thus one of ordinary skill in the art at the time the invention was made would expect the pellets as taught by Jones to maintain their individuality at a temperature of about -26C (i.e. including -25C) for up to 30 hours.

Jones teaches the premix can be dairy based (Column 4 lines 56-62), however, is silent to the specific composition utilized to form the ice cream dairy dessert, to specific optional ingredients, such as specific stabilizers and artificial sweeteners in specific amounts, that are included in the ice cream product as recited in claims 38, 50, 58, 61, 64-66, 69-75, and 83, to the frozen dessert as single phase products without fusing at temperatures of about -5C to about -10C or about -18C to about -20C or about -15C to about -18C as recited in claims 35, 36, 39, 41, 47, 48, 51, 53, 76, and 79, and to the total sugar content or sucrose as from 6-7.5% or 3.6-7.2% as recited in claims 34, 45, 46, 57, 59, 80, 83, and 84.

Tomita teaches that ice creams are generally made from 3-20% milk fat, 3-12% non-fat milk solids, 8-20% sugar, i.e. sucrose, and if necessary, a small amount of a stabilizer, an emulsifier, a color, flavors, and the like (Column 1 lines 45-64). Since Tomita does not teach bulking agents as part of the composition, Tomita teaches that bulking agents are not included in the ice cream (Column 1 lines 45-64).

Cole teaches of an ice cream product with a similar composition to that as taught by Jones in view of Tomita. Cole teaches that the ice cream premix contains 0-2%, preferably 0.1-0.6%, stabilizers, including gums, in order to improve the shelf life of the ice cream product (Column 6 lines 19-32). Cole teaches that artificial sweeteners, including saccharin and aspartame, were added to the ice cream premix in order to adjust the sweetness of the final composition (Column 6 lines 51-62).

Igoe, page 14, teaches that aspartame is an artificial sweetener, which is utilized, in frozen desserts. Igoe teaches that aspartame is used at a level of 0.01-0.02%.

Regarding the specific composition and premix utilized to form the ice cream dairy dessert, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mix comprising 3-20% milk fat, 3-12% non-fat milk solids, 8-20% sugar, no bulking agents, and if necessary, a small amount of a stabilizer, an emulsifier, a color, flavors, and the like for the ice cream dessert product as taught by Jones in view of Tomita. One would have been motivated to do so since Jones teaches of making a dairy based ice cream product but does not teach a composition for doing so, and since Tomita teaches of a general dairy based composition for ice cream products which provides for good flavor and excellent softness (Column 13 lines 12-25). One would have been further motivated for the ice cream ingredients to be combined in the form of a premix and for the ice cream to consist essentially of the premix so that the premix could be stored and when it was desirable to form the ice cream less processing steps were needed, i.e. such as measuring and combining all ingredients.

Regarding the ice cream premix as containing stabilizers, Cole teaches that preferably 0.1-0.6% stabilizers, including gums, are utilized in premixes for ice cream desserts in order to improve the shelf life of the ice cream product. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a premix comprising 0.1-0.6% gum (i.e. stabilizer) in the ice cream as taught by Jones in view of Cole. One would have been motivated to do so in order to improve the shelf stability of the dessert product as taught by Cole. To use known stabilizers in known amounts for their known function would not impart a patentable distinction to the claims.

Regarding the ice cream premix as containing artificial sweeteners, Cole teaches that artificial sweeteners, including saccharin and aspartame, were added to the ice cream mix in order to adjust the sweetness of the final composition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add an artificial sweetener, such as aspartame, to the ice cream mix in order to increase the

sweetness level of the final product as taught by Cole. It would have been further obvious to one of ordinary skill in the art at the time the invention was made to use 0.01-0.02% aspartame in the frozen premix as taught by Jones in view of Cole because it is a conventional amount of aspartame to be used in a frozen dessert as taught by Igoe. It would have been further obvious to one of ordinary skill in the art at the time the invention was made to add more than 0.02% aspartame when desiring to further increase the sweetness level of the final product. Furthermore, it would have been obvious to substitute one artificial sweetener for another artificial sweetener as to substitute one functional equivalent for another and would not make a patentable distinction to the claims. One of ordinary skill in the art at the time the invention was made would have been motivated to choose one artificial sweetener, such as sucralose, over another, such as aspartame, depending on sweeteners, the sweetening power desired, and which sweetener was most readily available and more affordable when the product was made.

Regarding the total sugar content or sucrose in the ice cream as from 6-7.5% or 3.6-7.2%, as stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include 8% sucrose as well as 0.01-0.02% aspartame, in the ice cream mix. It would have been further obvious to one of ordinary skill in the art to decrease the amount of sucrose in the ice cream mix when adding artificial sweeteners in order to produce an ice cream which possessed the same sweetness level but that did not require as much sugar. As aspartame was known to have a sweetness of 200 times sugar, it would have been obvious to include at least about 2-4% less sugar or about 4-6% sugar in the composition when including 0.01-0.02% aspartame. One would have been motivated to decrease the sugar content and increase the amount of artificial sweetener in order to form an ice cream dessert that did not contain excessive amounts of sugar as taught by Tomita and to form an ice cream dessert which was more diabetic friendly as it was known that diabetics reacted to sugars. To adjust the level of sweeteners and artificial sweeteners in a food product depending on the desired level of sugar and sweetness in the final product would have been obvious as it would be routine determination of one of ordinary skill in the art.

Regarding the frozen dessert as single phase products without fusing at temperatures of about -5C to about -10C or about -18C to about -20C or about -15C to about -18C, the modified Jones teach of substantially the same method and composition for producing the frozen confection as instantly claimed, thus one of ordinary skill in the art at the time the invention was made would expect the frozen confection as taught by the references would have substantially the same properties as the frozen confection as instantly claimed; one of ordinary skill in the art would expect that the references teach of a frozen dessert as single phase products without fusing at temperatures of about -5C to about -10C or about -18C to about -20C or about -15C to about -18C, absent any clear and convincing arguments and/or evidence to the contrary.

***Response to Arguments***

Applicant's arguments filed November 4, 2008 have been fully considered but they are not persuasive.

Applicant argues that the references of record do not teach of a frozen confection with the same properties as instantly claimed, such as single phase products without fusing at temperatures of about -5C to about -10C or about -18C to about -20C or about -15C to about -18C pelletized dessert that can maintain shape without fusing at the instantly claimed temperatures. Applicant's argument is not convincing as:

1. Applicant provides no evidence to support this statement; and
2. The references teach of substantially the same method and composition for producing the frozen confection as instantly claimed, thus one of ordinary skill in the art at the time the invention was made would expect the frozen confection as taught by the references would have substantially the same properties as the frozen confection as instantly claimed, absent any clear and convincing arguments and/or evidence to the contrary.

Applicant argues that the references of record do not teach of a sugar or sucrose content in the ice cream or premix below 8%. Applicant's argument is not convincing as it would have been obvious to one of ordinary skill in the art at the time the invention

was made to include 8% sucrose as well as artificial sweeteners, including 0.01-0.02% aspartame, in the ice cream mix. It would have been further obvious to one of ordinary skill in the art to decrease the amount of sucrose in the ice cream mix when adding artificial sweeteners in order to produce an ice cream which possessed the same sweetness level but that did not require as much sugar. As aspartame was known to have a sweetness of 200 times sugar, it would have been obvious to include at least about 2-4% less sugar or about 4-6% sugar in the composition when including 0.01-0.02% aspartame. One would have been motivated to decrease the sugar content and increase the amount of artificial sweetener in order to form an ice cream dessert that did not contain excessive amounts of sugar as taught by Tomita and to form an ice cream dessert which was more diabetic friendly as it was known that diabetics reacted to sugars. To adjust the level of sweeteners and artificial sweeteners in a food product depending on the desired level of sugar and sweetness in the final product would have been obvious as it would be routine determination of one of ordinary skill in the art.

Applicant argues that Tomita and Cole are non-analogous art as the references are directed to ice cream which is not formed by cryogenic freezing and thus one would not have been motivated to combine the references. Applicant's argument is not convening as it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art references are in the field of applicant's endeavor, specifically, the references are in the field of frozen confections, more specifically frozen ice creams.

Applicant argues that Cole teaches away from the instant invention by teaching that it can be desirable for ice cream to agglomerate. Applicant's argument is not convincing as Cole is relied upon for the general teaching of ice cream compositions and as Cole is a soft serve from dessert and not a pelletized product. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed

invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues that none of the references teach of decreasing the sugar content of the ice cream and further that one of ordinary skill in the art at the time the invention was made would not have been motivated to decrease the sugar content of the ice cream without the inclusion of bulking agents. As stated above, it would have been obvious to include at least about 2-4% less sugar or about 4-6% sugar in the composition when including 0.01-0.02% aspartame. One would have been motivated to decrease the sugar content and increase the amount of artificial sweetener in order to form an ice cream dessert that did not contain excessive amounts of sugar as taught by Tomita and to form an ice cream dessert which was more diabetic friendly as it was known that diabetics reacted to sugars. To adjust the level of sweeteners and artificial sweeteners in a food product depending on the desired level of sugar and sweetness in the final product would have been obvious as it would be routine determination of one of ordinary skill in the art. Regarding decreasing the sugar content without the addition of bulking agents, applicant's arguments are not convincing as the only bulking agent disclosed or recognized by applicant's disclosure is maltodextrin and the references of record do not teach that maltodextrin is necessary in the ice cream compositions. Applicant's disclosure includes ingredients within the ice cream composition which function as bodying agents (such as non-fat milk solids) and thus could be considered bulking agents; however, applicant does not classify these ingredients as bulking agents. Therefore, for the purpose of prior art comparison, the term bulking agents as defined by applicant is directed to the disclosed bulking agent maltodextrin and not to any ingredient which can function as a bulking or bodying agent. Furthermore, applicant provides no unexpected results or criticality with regard to the instantly claimed sugar content and the instantly claimed sugar content with no bulking agents.

Applicant further argues that Cole includes bulking agents with sugars and artificial sweeteners. Applicant argues that Cole classifies starch hydrolysates as well as non-fat milk solids as bulking agents. Applicant's argument is not convincing as Cole

teaches of carbohydrates, sweeteners, and proteins. Cole teaches that ingredients function as bodying agents in addition to providing other functions. As stated above, the only bulking agent disclosed or recognized by applicant's disclosure is maltodextrin and the references of record do not teach that maltodextrin is necessary in the ice cream compositions. Applicant's disclosure includes ingredients within the ice cream composition which function as bodying agents (such as non-fat milk solids) and thus could be considered bulking agents, however, applicant does not classify these ingredients as bulking agents. Therefore, for the purpose of prior art comparison, the term bulking agents as defined by applicant is directed to the disclosed bulking agent maltodextrin and not to any ingredient which can function as a bulking or bodying agent. Additionally it is noted that similarly although the reference teaches components which are bodying agents, the reference does not classify the components as bulking agents.

Applicant further argues that every example of Tomita contains hydrolyzed starch which is a bulking agent. Applicant's argument is not convincing. As stated above the only bulking agent disclosed or recognized by applicant's disclosure is maltodextrin and the references of record do not teach that maltodextrin is necessary in the ice cream compositions. Applicant's disclosure includes ingredients within the ice cream composition which function as bodying agents (such as non-fat milk solids) and thus could be considered bulking agents, however, applicant does not classify these ingredients as bulking agents. Therefore, for the purpose of prior art comparison, the term bulking agents as defined by applicant is directed to the disclosed bulking agent maltodextrin and not to any ingredient which can function as a bulking or bodying agent. Additionally, it is noted that although Tomita teaches of starch hydrolysate in the Examples, the disclosure of the reference does not require starch hydrolysate in the ice cream composition nor does it distinguish the component as a bulking agent.

Furthermore, it is noted that applicant refers to a reference, Ice Cream by Marshall Table 2.1 and pages 75 and 76 (Remarks pages 15 and 16). Although applicant has submitted the reference, Ice Cream by Marshall Table 7.1 and pages 175 and 176, applicant has not submitted the pages referred to in the remarks and thus the remarks are unsupported.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Bekker whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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